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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------------|-------------|----------------------|---------------------|------------------|
| 09/706,195 | 11/03/2000 | Peter Smith | ENSEMB.032A | 6398 |
| 43831 | 7590 | 07/12/2005 | EXAMINER | |
| BERKELEY LAW & TECHNOLOGY GROUP | | | KIM, KEVIN | |
| 5250 NE ELAM YOUNG PARKWAY | | | ART UNIT | |
| SUITE 850 | | | PAPER NUMBER | |
| HILLSBORO, OR 97124 | | | 2638 | |

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/706,195

Applicant(s)

SMITH ET AL.

Examiner

Kevin Y. Kim

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3-7,15,17-22 and 24-28 is/are allowed.
- 6) ☒ Claim(s) 2,8-11,16,23 is/are rejected.
- 7) ☒ Claim(s) 13 and 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shinozaki (US 6,505,033) in view of Pratt et al (US 6,757,837).

Claims 8 and 11.

Referring to Fig.2. Shinozaki discloses a system used in a radio communication system, which comprises a plurality of base stations and customer sites, comprising;

an outdoor unit (2) comprising software instructions stored in a memory (6), see col.5, line 3-5,

an indoor unit (1) comprising a copy of the stored software instructions stored in a memory (5), see col.4, lines 56-59, and determining content of the memory (6), see col. 3, lines 23-27.

But Shinozaki fails to teach “first instructions within the indoor unit for detecting a failure in the outdoor unit and, responsive to said failure, storing new software instructions to the memory in said outdoor unit.” When a fault occurs in any device, a spare unit is substituted for the defective unit, see col.1, lines 45-48, presumably manually, i.e., by a technician. Pratt et al disclose a client/server system where a server is notified of a failure of a client and the server downloads and executes software to repair the failure. This remote updating of defective software obviates a need for costly repair by technicians. See Abstract and col.9, line 60 to col.10, line 47 in particular.

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Thus, it would have been obvious to one skilled in the art at the time the invention was made to provide “instructions” at the indoor unit of Shinozaki, which acts like a server, to respond to failure of the outdoor unit, i.e., a client, such that the indoor unit downloads “new software instructions” to the outdoor unit for remote repair of the faulty outdoor unit, thereby reducing repair cost associated with the use of technicians.

Regarding the partition of the memory, the benefit of partitioning a memory is well established partitioned since it allows partitions/blocks individually erased and reprogrammed.

Regarding claims 9,10, Shinozaki describes the memories are formed with a PROM, which is one of the elements in the group of memories recited in the claim. See col. 4, line 56-57.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2,9, 16 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims define various types of memory to be used as “the memory” or “the memory partitions.” However, the language using “at least one of” in combination of “and/or” makes the claims indefinite.

Allowable Subject Matter

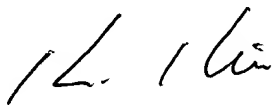
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3. Claims 2,16 and 23 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.
4. Claims 13 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
5. Claims 1,3-7,15,17-22,24-28 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Y. Kim whose telephone number is 571-272-3039. The examiner can normally be reached on 8AM --5PM M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kenneth Venderpuye can be reached on 571-272-3078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**KEVIN KIM
PATENT EXAMINER**